

(3.18) but a very different environment which has uniquely shaped my invention.

I need to emphasize this *streaming* surface, because the examiner seems to have missed its significance. He does not discuss my claim 24, which addresses the relationships of proportion, weight, and thickness necessary for water adhesion of a book on a streaming surface. There is no teaching of these relationships in Logan or Kramer. And the examiner, in dismissing my claims 25 and 29 as “a matter of design choice” (3.4) “to accomodate any particular user”(3.5) misses the same point again. These claims address essentials of support and legibility on a *streaming* surface.

Not only is there no teaching in Logan or Kramer for use on a streaming surface, there is furthermore no suggestion in them to combine their teachings.

This sort of inappropriate combination has been addressed in certain decisions of the USPTO Board Of Patent Appeals. Please see their January 13, 2005 decision regarding Appeal No. 2004-0953, Application No. 09/215,593 (copy enclosed). In reversing the examiner’s decision, the Board made arguments relevant to our own case. They supported appellants’ assertions “that there is no suggestion to combine the teachings of the prior art, and that the references teach away from the combination” and “ even if the invention could somehow be pieced together from various elements of the cited references, it would have been necessary to utilize the claimed invention as a roadmap in order to do so.” (7.12). The Board found “no teaching to combine these references...to arrive at appellants’ invention, other than from reliance on applicants’ disclosure.” (8.13). They further stated: “The mere fact that the prior art references are analogous and could be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification.” (8.20). And the Board concluded that the examiner had “added the additional references in a hindsight reconstruction of appellants’ invention using appellants’ claims as a roadmap for combining the teachings of the prior art. The use of such hindsight knowledge to support obviousness rejections under 35 U.S.C. 103 is, of course, impermissible.”

The examiner concludes by reminding (4.9) that “the test is what the combined teachings

of the references would have suggested to those of ordinary skill in the art." But arguably, as discussed above, Logan and Kramer, not having suggested combination, are improperly combined. Also, one might well ask, what persons in our case besides Logan and Kramer are "those of ordinary skill in the art"? Presumably they are the present inventor, and the "countless number of people" (2.18) who sing in the shower.

Well, I as one of "ordinary skill" in this art, did not find this invention obvious, but arrived at it through long experiment. To repeat a few lines from my previous response: "It was not obvious to me, at the time I conceived the invention, that a waterproof lyrics display to aid singing in the shower was even possible. It wasn't obvious what form such a display should take; my initial experiments---all discarded now along the way---involved plastic bags, boxes, and laminations. It wasn't obvious that a person could read song lyrics through the heavy downpour of water or the poor illumination of the usual shower enclosure. It wasn't obvious what size and style of print might make this possible. It wasn't obvious that a book of lyrics could be supported solely by water adhesion; I tried all sorts of other supports (suction cups, brackets, etc.) first. It wasn't obvious that water adhesion support alone could sufficiently resist the flooding of water down the wall. It wasn't obvious that paper would work as the material; I tried stiff sheets of plastic, shower curtain vinyl, and other materials first, thinking that waterproof paper would blister when wet, then buckle and fall like ordinary paper. It wasn't obvious that waterproof paper was sufficiently impermeable to retain a water film between itself and the shower wall; or that the water film would not soon leach away at the edges. It wasn't obvious that water adhesion support could be maintained even though the joints usual between wall tiles might allow downpouring water to penetrate. It wasn't obvious that inks sufficiently waterproof to withstand the heavy downpour of a shower (equivalent to a cloudburst, or several cloudbursts daily) were available; or that those inks would hold sufficiently fast to waterproof paper. It wasn't obvious that slim proportions---as in a magazine or pamphlet---were critical for a book to be supported solely by water adhesion. It wasn't obvious what the range of those slim proportions should be. It wasn't obvious that the slippery pages of a waterproof book adhered to a shower wall could be easily grasped and turned in the downpour of a shower. It wasn't obvious that the height of such a book on the wall could be adjusted by sliding. Finally, it wasn't obvious that the invention, by the seemingly simple act of

displaying lyrics, would instantly and dramatically improve one's singing."

As for the "countless number" of singers in the shower, millions and millions of them, not all their "ordinary skill in the art" exercised for hundreds of years has produced the present invention with all its potential benefits. Why? Because the invention is not obvious.

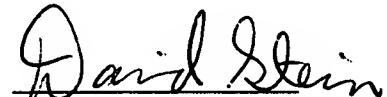
It seems to me that an examiner's judgement must sometimes rely on subjective factors. And perhaps this tendency is greatest when the invention, however original and difficult, seems at first glance a simple one. I hope the examiner will set this impression of simplicity aside.

The rejected claims are revisited below--- several of them revised to emphasize a surface *streaming* with water. (Included for the examiner's consideration is Claim 49, which seems to have been overlooked in the office action.) Because my revisions to the claims are few, and the supporting arguments were detailed in my previous response, I hope the examiner, if need arises, will refer to that document.

Respectfully submitted,

David Stein, inventor

Dated: Oct. 4, 05



DAVID STEIN
319 West 106th Street #2A
New York, NY 10025
212-663-2325
davidstein6314@earthlink.net